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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,699	03/27/2001	Doug L. Rollins	MPATENT.163A	9926

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EXAMINER

NGUYEN, MINH DIEU T

ART UNIT PAPER NUMBER

2137

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/818,699

Applicant(s)

ROLLINS, DOUG L.

Examiner

Minh Dieu Nguyen

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 2-4 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 5-9, drawn to method of transferring and retrieving encrypted data files, classified in class 380, subclass 277.
  - II. Claims 2-4, drawn to method of storing data files, classified in class 713, subclass 193.
2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as storing and copying data files over a remote network server. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with John King on 12/2/2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1 and 5-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2-4 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Botham, Jr. et al. (6,785,812).

Botham discloses an arrangement for secure and controlled electronic distribution of documents from a server to clients (Fig. 1) comprising: storing a public and private key in a client computer system (Fig. 1, element 129); sending a request for a data file from client to server (Fig. 2, element 210); and in response to the request, checking a file attribute to determine that the file is to be encrypted with the public key, automatically retrieve the public key from client computer system, encrypting the data file with the public key automatically and without user intervention (col. 4, lines 4-16) and sending the encrypted data file to the client computer system (col. 4, lines 17-18).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Botham, Jr. et al. (6,785,812) in view of Morgan et al. (2001/0001876).

The large portion of claim limitations is in claim 1 with the addition of storing the encrypted data file on a storage medium in the client computer system that Botham does not disclose.

Morgan discloses a method and system for persistent storage and data communications on computer networks comprising storing encrypted data in storage at the client computer location (page 2, paragraph [0025]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of storing encrypted data at client computer as Morgan teaches in the system of Botham so as to minimize the possibility of access being gained to data.

9. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Botham, Jr. et al. (6,785,812) in view of Cochran et al. (6,701,324) and further in view of Prihoda et al. (6,789,195).

Botham discloses the step of associating a permission (Fig. 2, element 121) with a file, however he does not disclose an attribute.

Cochran discloses the file attributes include compression flags, checksums and encryption information (col. 8, lines 16-20).

Both Botham and Cochran do not disclose the attribute indicating the file is unencrypted when stored on the server.

Prihoda discloses the data are encrypted while being transmitted between the client and server, the data then exist in unencrypted form at the central point and are generally stored in unencrypted form in a central database (col. 1, lines 22-27).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of attribute to indicate file is unencrypted when stored on the server as Prihoda teaches in the system of Botham and Cochran so as to provide adequate protection to data.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Botham, Jr. et al. (6,785,812) in view of Eldridge et al. (6,094,721).

Botham does not disclose the public and private key are based on a password.

Eldridge discloses a method and apparatus for updating the password status of one of more servers in a client/server environment comprising public and corresponding private key derived from password (col. 5, lines 33-46).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of generating public and private key from a password as Elridge teaches in the system of Botham so as to secure password access.


**Conclusion**

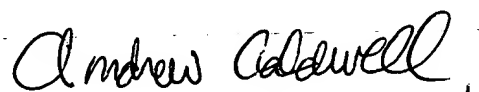
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 571-272-3873. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

Minh Dieu Nguyen  
Examiner  
Art Unit 2137

  
mdn  
12/3/04

  
Andrew Caldwell